



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,732	12/21/2000	Waldemar Kiener	(MM) 54 039	6906

7590 10/26/2004

M. ROBERT KESTENBAUM
11011 BERMUDA DUNES, NE
ALBUQUERQUE, NM 87111

EXAMINER

GOFF II, JOHN L

ART UNIT	PAPER NUMBER
----------	--------------

1733

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,732

Applicant(s)

KIENER ET AL.

Examiner

John L. Goff

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-13 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 15-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the amendment filed 8/18/04. The previous claim objections and 35 USC 112 rejections have been overcome.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

3. The drawings were received on 8/27/04. These drawings are acceptable.

Claim Objections

4. Claim 4 is objected to because of the following informalities: In claim 4, line 1 delete the second "according".

Claim Rejections - 35 USC § 112

5. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 12 recites the limitation "the supply rolls" in line 2. There is insufficient antecedent basis for this limitation in the claim. If claim 12 were amended to depend from claim 11 the rejection would be overcome.

Claim Rejections - 35 USC § 103

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 3, 4, and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuhaus et al. (U.S. Patent 4,389,472) in view of and the admitted prior art (Specification pages 1-2).

Neuhaus et al. disclose a method for forming tamperproof documents (documents that cannot be falsified such as credit cards, company cards, etc.) by laminating an information carrier with a plastic foil on one or both sides wherein the plastic foil has an adhesive layer that is hardened by UV radiation (Column 1, lines 5-7 and 53-66 and Column 7, lines 33-35 and Column 12, lines 31-37). Neuhaus et al. teach the method comprises providing a supply roll of plastic foil (e.g. polyethylene) including a layer of UV curable adhesive, corona discharge treating the plastic foil, providing an information carrier (e.g. photo-polymer film), continuously laminating the information carrier on one or both sides with the plastic foil to form a laminate, exposing the laminate to UV radiation to cure the adhesive, and then cutting the laminate into individual tamperproof documents such as credit cards (i.e. further processing into forgery-proof documents) (Column 9, lines 49-50 and Column 10, lines 3-10 and 30-43 and Column 11, lines

Art Unit: 1733

17-26, 28-36, and 53-56). Neuhaus et al. are silent as to using an information carrier provided on each side with a protective/supporting film that is removed prior to laminating with the plastic foil. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the information carrier taught by Neuhaus et al. one that is provided with protective/supporting films during its production as it was well known and conventional in the art to provide an information carrier with these films during production for protection/support of the information carrier prior to its application (the films being removed prior to application due to their high processing temperatures) as shown for example by the admitted prior art.

Regarding claims 1 and 7, Neuhaus et al. as modified by the admitted prior art are silent as to delaminating/laminating each side of the information carrier in a sequential or simultaneous manner. However, it would have been well within the purview of one of ordinary skill in the art at the time the invention was made to process each side of the film separately or together as only the expected results would be achieved, i.e. either method would produce the same product.

Regarding claim 10, Neuhaus et al. teach the information carrier includes a photo-polymer film. Neuhaus et al. do not specifically recite a hologram. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the photo-polymer layer taught by Neuhaus et al. a hologram as it was well known and conventional in the art to use as the photo-polymer layer in an information carrier a hologram as shown for example by the admitted prior art wherein only the expected benefits (e.g. increased security of the information layer) would be achieved.

The admitted prior art discloses known processes for producing forgery proof documents. The admitted prior art teaches that information carriers (e.g. polymer films such as holograms) are provided with protective/supporting films on both sides during their production (Specification page 2, lines 1-5). The admitted prior art further teaches removing the protective/supporting films prior to processing the information carrier into a forgery proof document due to the high processing temperatures of the protective films (Specification page 2, lines 7-13).

9. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuhaus et al. and the admitted prior art as applied above in paragraph 8, and further in view of Ueda et al. (U.S. 5,755,919).

Neuhaus et al. and the admitted prior art as applied above teach all of the limitations in claims 4-6 except for a specific teaching of providing the information carrier to the process on a supply roll and performing the delaminating and laminating steps by passing the information carrier around a roll having delaminating, UV curing, and laminating stations placed around the circumference thereof. However, Neuhaus et al. are silent and are not limited to any particular means for supplying the information carrier such that it would have been obvious to one of ordinary skill in the art at the time the invention was made to supply the information carrier, e.g. photo-polymer film, taught by Neuhaus et al. as modified by the admitted prior art from a supply roll as it was well known and conventional in the art to supply photo-polymer film to a delaminating and laminating process in this manner as shown for example by Neuhaus et al. Furthermore, Neuhaus et al. are silent and are not limited to any particular laminating apparatus such that it would have been obvious to one of ordinary skill in the art to perform the method

Art Unit: 1733

taught by Neuhaus et al. as modified by the admitted prior art using any well known and conventional apparatus for delaminating/curing/laminating on a film such as by the apparatus shown for example by Ueda et al. (including a roll for wrapping the film at least 180° having delaminating, UV curing, and laminating stations around the circumference thereof) wherein only the expected results would be achieved.

Ueda et al. disclose a process for delaminating and laminating on a photo-polymer film. Ueda et al. teach providing a photo-polymer film supply roll including protective/supporting films on both sides of the photo-polymer film, providing a roll having delaminating, UV curing, and laminating stations placed around the circumference thereof, supplying the photo-polymer film to the roll such that the film wraps the roll by at least 180°, removing at least one of the protective/supporting films, applying UV curing light to the photo-polymer film to duplicate a pattern in the roll on the photo-polymer film, laminating a second protective/supporting film onto the photo-polymer film, and then rolling the laminate to form an information carrier roll (Figures 6(a) and 6(b) and Column 7, lines 14-67 and Column 8, lines 1-20).

10. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuhaus et al, the admitted prior art, and Ueda et al. as applied above in paragraph 9, and further in view of Butler et al. (U.S. Patent 3,822,838).

Neuhaus et al., the admitted prior art, and Ueda et al. teach all of the limitations in claims 11 and 12 except for a teaching on using a splicer and a storage device to ensure the continuous supply of information carrier, i.e. photo-polymer film. Butler et al. are directed to an apparatus for providing an uninterrupted supply of a web material from a supply roll to a machine that consumes the web at a high speed (Column 1, lines 7-10). Butler et al. teach that the apparatus

Art Unit: 1733

comprises a splicer to automatically splice in a new roll when the running roll is depleted and an accumulator to ensure the web is continuously supplied to the web consuming machine when a new roll is being spliced (Figure 1 and Column 1, lines 10-21). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate into the method taught by Neuhaus et al. as modified by the admitted prior art and Ueda et al. the splicer and storage device taught by Butler et al. to ensure a continuous supply of photo-polymer film.

Response to Arguments

11. Applicant's arguments filed 8/18/04 have been fully considered but they are not persuasive. Applicant argues, "the first difference between Neuhaus and the present application is that Neuhaus forms ends products". The claims are not commensurate in scope with this argument. The claims require a process for producing a laminate... .. for further processing for forgery-proof documents. The claims do not require any specific further processing steps or even that further processing be performed rather the claims merely require the laminate be capable of further processing a limitation clearly satisfied by Neuhaus et al. In any event, Neuhaus et al. specifically teach further processing the laminate by cutting the laminate into individual forgery-proof documents. Applicant further argues, "Since the plastic foil should be bonded indissolubly, Neuhaus has not considered using an information carrier provided on each side with a protective/supporting film that is removed prior to laminating with plastic foil". Neuhaus et al. teach the plastic foils are bonded indissolubly with the information carrier through a UV curable adhesive wherein this bonding is irrespective of whether or not the information carrier is initially supplied with protective/supporting films that are removed prior to the

Art Unit: 1733

bonding. The admitted prior art is applied in combination with Neuhaus et al. to show the well known and conventional technique of supplying an information carrier of the type taught by Neuhaus et al. having protective/supporting films for the obvious benefits, it being further noted the well known and conventional technique of forming an information carrier with protective/supporting films has not been challenged by applicant such that any arguments thereto have been acquiesced. Applicant further argues, "Therefore, Ueda's steps for creating a laminate are different from the present invention as claimed. Further, Ueda's assembly of the laminate is different and is made of different films". Claims 4-6 require supplying the information carrier from a supply roll and using a laminating device comprising a roll for wrapping the information carrier at least 180° having delaminating, UV curing, and laminating stations around the circumference thereof. Ueda et al. is not applied to teach the claimed process rather Ueda et al. is combined with Neuhaus et al. as exemplary of well known and conventional apparatus used in processes of the type taught by Neuhaus et al. for forming a laminate wherein the laminating device taught by Ueda et al. meets the claim limitations.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period


Art Unit: 1733

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is (571) 272-1216. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John L. Goff



JEFF H. AFTERCUT
PRIMARY EXAMINER
GROUP 1300